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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,941	02/22/2000	Masato Ochiai	35.C14278	2960
5514	7590	12/01/2003	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			ENGLAND, DAVID E	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)
	09/507,941	OCHIAI, MASATO
	Examiner David E. England	Art Unit 2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1, 2, 4 – 6, 8 – 10, 12, 13, 15 – 17, 19 – 21, 34, 42 and 45 – 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1, 2, 4 – 6, 8 – 10, 12, 13, 15 – 17, 19 – 21, 34, 42 and 45 – 48 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) Interview Summary (PTO-413) Paper No(s). _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

1. Claims 1, 2, 4 – 6, 8 – 10, 12, 13, 15 – 17, 19 – 21, 34, 42 and 45 – 48 are presented for examination.

Claim Objections

1. Claims 2 and 13 are objected to because of the following informalities: The section that states, “wherein in a”, does not appear to be proper sentence structure. Appropriate correction is required.
2. Claim 13 is objected to because of the following informalities: The claim has two sets of brackets that encloses the word if, [[if]], and it is not clear as to the meaning of the brackets. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1, 5, 6, 8, 12, 16, 17, 19, 34 and 47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the

art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation of “special attribute” is not described in the specification nor does the specification state that a “special attribute” has a connection to “data length” or “TTL”.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 2, 4, 5, 12, 13, 15, 16, 34, 47 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Beser U.S. Patent No. 6189102.

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7. Referencing claim 1, as interpreted by the Examiner, Beser teaches a network apparatus comprising:

8. a receiving unit adapted to receive data from a network by using a predetermined protocol, (e.g. col. 14, line 38 – col. 16, line 35);

9. a detecting unit adapted to receive a special attribute in a packet header of the data received by said receiving unit, the packet header being provided for the predetermined protocol, (e.g. col. 14, line 38 – col. 16, line 35, “*HOPS 116, XID 118, FLAGS 122*”); and

10. a setting unit adapted to set an address of said network apparatus in accordance with a destination address of the received data in a case where the special attribute is detected by said detecting unit, (e.g. col. 14, line 38 – col. 16, line 35, “*BOOTP*”).

11. Referencing claim 2, as interpreted by the Examiner, Beser teaches in a case where a destination logic address of the received data and a logic address of said apparatus differ and a destination physical address of the received data and a physical address pf said apparatus are the same, said setting unit sets logic address of said apparatus in accordance with the destination logic address of the received data, (e.g. col. 14, line 38 – col. 16, line 35, “*BOOTP*”).

12. Referencing claim 4, Beser said physical address is a media access control address, and the logic address is an Internet protocol address, (e.g. col. 14, line 38 – col. 16, line 35 & col. 18, line 49 – col. 19, line 16).

13. Referencing claim 5, as interpreted by the Examiner, Beser teaches said setting unit sets the address of said apparatus in accordance with the destination address of the received data if a destination physical address of the received data and a physical address of said apparatus are the same and the special attribute is detected by said detecting unit, (e.g. col. 14, line 38 – col. 16, line 35, “*BOOTP, HOPS 116, XID 118, FLAGS 122*”).

14. Claims 12, 13, 15, 16, 34, 47 and 48 are rejected for similar reasons as stated above.

15. Claims 45 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Nixon et al. U.S. Patent No. 6266726 (hereinafter Nixon).

16. Referencing claim 45, Nixon teaches a network apparatus comprising:

17. a receiving unit adapted to receive data from a network by using a predetermined protocol, (e.g. col. 25, lines 31 – 55, “*Cards, Ports and devices*”);

18. a detecting unit adapted to receive a special attribute in a packet header of the data received by said receiving unit, the packet header being provided for the predetermined protocol, (e.g. col. 26, line 24 – col. 27, line 18, “*UDP datagram*”); and

19. a setting unit adapted to set a factory-based value in a case where the special attribute is detected by said detecting unit, (e.g. col. 26, line 24 – col. 27, line 18, “*UDP datagram, default primary address*”).

20. Reverencing claim 46, Nixon teaches said setting unit sets the factory-based value if a destination physical address of the received data and a physical address of said apparatus are the same and the special attribute is detected by said detecting unit, (e.g. col. 26, line 24 – col. 27, line 18, “*UDP datagram, default primary address*”).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 6, 8 – 10, 17, 19 – 21 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beser (6189102) in view of Anderson et al. (5850388) (hereinafter Anderson).

23. Referencing claim 6, Beser does not specifically teach the received data is an ICMP echo message by an ICMP protocol and the special attribute is a data length of the ICMP echo message. Anderson teaches the received data is an ICMP echo message by an ICMP protocol and the special attribute is a data length of the ICMP echo message, (e.g. col. 12, lines 22 – 56 & col. 20, line 54 – col. 21, line 30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Anderson with Beser because it would be more efficient for a system to not have to shut down an end system and turn back on to receive a new IP

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address as with the functionality of BOOTP. Using an ICMP echo would allow a user to keep the end system on and receive a new IP address without the burden of turning the end system off. Furthermore, utilizing a data length, sometimes known as a “checksum” or “CRC”, allows the end system to check for errors in the packet if the data length is not to a predetermined length.

24. As per claim 8, Beser does not teach the special attribute is a TTL value of the received data. Anderson teaches the special attribute is a TTL value of the received data, (e.g. col. 21, line 59 – col. 22, line 24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Anderson with Beser because it is more efficient for a packet to have a TTL field in a packet so if the packet is taking too long to be transmitted through the Internet the packet could be dropped and aid in congestion control in a network.

25. Claims 9, 10, 17, 19 – 21 and 42 are rejected for similar reasons stated above.

Conclusion

26. Applicant's arguments with respect to claims 1, 2, 4 – 6, 8 – 10, 12, 13, 15 – 17, 19 – 21, 34, 42 and 45 – 48 are have been considered but are moot in view of the new ground(s) of rejection.

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

28. a. Dillon U.S. Patent No. 6016388 discloses Method and apparatus for requesting and retrieving information from a source computer using terrestrial and satellite interfaces.
29. b. Subramaniam et al. U.S. Patent No. 6016388 discloses Method and apparatus for configuring a network node to be its own gateway.
30. c. Davis et al. U.S. Patent No. 5896382 discloses Method and apparatus for communicating information between a headend and subscriber over a wide area network.
31. d. Kurio U.S. Patent No. 5774640 discloses Method and apparatus for providing a fault tolerant network interface controller.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is none.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is none.

David E. England
Examiner
Art Unit 2143

De *DE*



BRIAN J. ANDERSON
PRIMARY EXAMINER